



IFN/1764

Docket No.: 3893-0230PUS2
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas Peter SABROE et al.

Application No.: 10/549,315

Confirmation No.: 8221

Filed: September 16, 2005

Art Unit: N/A

For: STEREOSELECTIVE SYNTHESIS OF
VITAMIN D ANALOGUES

Examiner: Not Yet Assigned

LETTER ACCOMPANYING INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant files concurrently with this Letter, an Information Disclosure Statement. A Declaration signed by Thomas Peter Sabroe is attached and accompanies the reference "Sabroe, Thomas Peter, Chirale allylalkoholer ved asymmetrisk induktion., Declaration and Abstract, DANMARKS TEKNISKE UNIVERSITET, Institut for Ogranisk Kemi, 1997. This Declaration is provided because the reference is a master's thesis in the Danish language, and the Declaration provides a partial English translation together with describing the circumstances regarding the disclosure of the described subject matter.

Also enclosed are copies of the documents that were cited in the International Search Report of parent application PCT/DK2005/000161, and listed on the Form PTO-SB08 filed with the Information Disclosure Statement on September 16, 2005. (U.S. Patent 6,531,460-B1 is not necessary to provide.) The Information Disclosure Statement filed September 16, 2006 did not provide a copy of the reference WO-87/00834. A copy is submitted herein for the Examiner's convenience and assurance that the reference has been duly provided.

The PTO is requested to make these documents of record in the file of the present application and to return the initialed Form PTO-1449 to the undersigned.

Application No.: 10/549,315

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: October 6, 2006

Respectfully submitted,

By 

Andrew D. Meikle

Registration No.: 32,868

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Attachments: Information Disclosure Statement

PTO/SB08

References (6)



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INFORMATION DISCLOSURE STATEMENT
(SUBMISSION AFTER FILING OF AN APPLICATION BUT BEFORE FINAL
REJECTION OR NOTICE OF ALLOWANCE OR CONCURRENTLY WITH A RULE
1.114 RCE APPLICATION)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §§ 1.97 and 1.98, applicant(s) hereby submit(s) an Information Disclosure Statement for consideration by the Examiner.

I. LIST OF PATENTS, PUBLICATIONS OR OTHER INFORMATION

The patents, publications, or other information submitted for consideration by the Office are listed on the PTO-SB08(s), attached hereto.

II. COPIES

- ☒ a. Copies of cited U.S. patents and patent application publications are not included.
Copies of foreign patent documents and non-patent literature are included.

☐ b. Some or all of the documents listed on the PTO-SB08 are not enclosed because they were cited in the International Search Report and copies should already be in the PTO file. If copies are needed, please contact the undersigned.

☒ c. REFERENCES PREVIOUSLY CITED OR SUBMITTED - Pursuant to 37 C.F.R. §1.98(d), consideration of information listed on the PTO-SB08 form(s) is requested since any patents, publications, or other information which are listed on the PTO-SB08 form(s) were previously cited by or submitted to the PTO in one of the following applications which has been relied upon for an earlier filing date under 35 U.S.C. § 120:

U.S. Appl. No(s) and U.S. Filing Date

PCT/DK2005/000161 filed March 10, 2005

Please also refer to the Letter Accompanying Information Disclosure Statement filed concurrently herewith. A copy of WO 87/00834-A is provided for the Examiner's convenience.

III. CONCISE EXPLANATION OF THE RELEVANCE

(check at least one box)

☐ a. DOCUMENTS IN THE ENGLISH LANGUAGE - The patents, publications, or other information listed on the attached PTO SB08 are in the English language and therefore, do not require a statement of relevancy.

☒ b. DOCUMENTS NOT IN THE ENGLISH LANGUAGE - A concise explanation of the relevance of all patents, publications, or other information listed that is not in the English language is as follows: *Please refer to the Letter Accompanying Information Disclosure Statement filed concurrently herewith. A Declaration is provided for Sabroe, Thomas Peter (Masters Thesis).*

☒ c. ENGLISH LANGUAGE SEARCH REPORT - An English language version of the search report or action that indicates the degree of relevance found by the foreign office *was filed on 09/16/05* thereby satisfying the requirement for a concise explanation. See MPEP 09(III)(A)(3).

☒ d. OTHER - The following additional information is provided for the Examiner's consideration. *Please refer to the Letter Accompanying Information Disclosure Statement filed concurrently herewith.*

IV. FEES (check one box)

☐ a. This Information Disclosure Statement is being filed concurrently with the filing of a new patent application; therefore, no fee is required.

☐ b. This Information Disclosure Statement is being filed concurrent with the filing of a continuation-in-part, continuation, or divisional patent application; therefore, no fee is required.

☐ c. This Information Disclosure Statement is being filed within three months of the filing date of a national application (37 C.F.R. § 1.97(b)(1)). No fee or statement is required. *(This section is not to be used with RCE's.)*

☐ d. This Information Disclosure Statement is being filed within three months of the date of entry of the national stage as set forth in § 1.491 in an international application (37 C.F.R. § 1.97(b)(2)). No fee or statement is required.

☐ e. This Information Disclosure Statement is being filed concurrently with the filing of a Request for Continued Examination under § 1.114 (37 C.F.R. § 1.97(b)(4)). No fee or statement is required.

☒ f. This Information Disclosure Statement is being filed before the mailing date of a first Action on the merits (37 C.F.R. § 1.97(b)(3)). No fee or statement is required. In the event that a first Office Action on the merits has been issued, please consider this IDS under 37 C.F.R. § 1.97(c) and see the statement under 37 C.F.R. § 1.97(e) below, or, if no statement has been made, charge our deposit account for the fee as required by 37 C.F.R. § 1.17(p).

☐ g. This Information Disclosure Statement is being filed before the mailing date of a Final Office Action under 37 C.F.R. § 1.113 (See 37 C.F.R. § 1.97(c)(1)) or before the mailing date of a Notice of Allowance under 37 C.F.R. § 1.311 (See 37 C.F.R. § 1.97(c)(2)).

☐ No statement; therefore, a fee as required by 37 C.F.R. § 1.17(p) is attached.
or

☐ See the statement below. No fee is required.

V. STATEMENT UNDER 37 C.F.R. § 1.97(e)

(check only one box)

The undersigned hereby states that:

☐ a. **Each item of information contained in the IDS was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than 30 days prior to the filing of this IDS; or**

☐ b. Each item of information contained in the IDS was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS; or

☐ c. No item of information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS.

☐ d. Some of the items of information were cited in a communication from a foreign Patent Office. As to this information, the undersigned states that each item of information contained in the IDS was first cited in a communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS. As to

the remaining information, the undersigned hereby states that no item of this remaining information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application and, to the best of my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this statement.

VI. PAYMENT OF FEES (check one box)

- ☐ The required fee is listed on the attached Fee Transmittal.
- ☒ No fee is required.

If the Examiner has any questions concerning this IDS, he/she is requested to contact the undersigned. If it is determined that this IDS has been filed under the wrong rule, the PTO is requested to consider this IDS under the proper rule and charge the appropriate fee to Deposit Account No. 02-2448.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for

Application No.: 10/549,315


Docket No.: 3893-0230PUS2

any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: October 6, 2006

Respectfully submitted,

By


Andrew D. Meikle

Registration No.: 32,868

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

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Falls Church, Virginia 22040-0747

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Attorney for Applicant

Attachment(s):



PTO-SB08



Documents



Foreign Search Report (*was filed on 09/16/05*)



Fee



Other: *Please refer to the Letter Accompanying Information Disclosure Statement filed concurrently herewith.*



PTO/SB/08a/b (07-06)
Approved for use through 09/30/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449A/B/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)				Complete If Known	
				Application Number	10/549,315-Conf. #8221
				Filing Date	September 16, 2005
				First Named Inventor	Thomas Peter SABROE
				Art Unit	N/A
				Examiner Name	Not Yet Assigned
Sheet	1	of	1	Attorney Docket Number	3893-0230PUS2

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			
	AA*	US-6,531,460-B1	03-11-2003	TAKENOUCHI et al.	

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ³
		Country Code ³ -Number ⁴ -Kind Code ⁵ (if known)				
	BA	WO-87/00834-A	02-12-1987	Leo Pharmaceutical Products Ltd.		
	BB	WO-WO98/24800	06-11-1998	Magainin Pharmaceuticals inc.		

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. * CITE NO.: Those application(s) which are marked with an single asterisk (*) next to the Cite No. are not supplied (under 37 CFR 1.98(a)(2)(iii)) because that application was filed after June 30, 2003 or is available in the IFW. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS				
Examiner Initials	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.		
	CA	Ishiguro et al, "Stereoselective introduction of Hydroxy-groups into the 24-, 25-, and 26-Positions of the Cholesterol Side Chain, J.C.S. Chem. Comm., 115-117, 1981, p. 115-117		
	CB	Calverley, Martin J., "Synthesis of MC 903, A Biologically Active Vitamin D Metabolite Analogue," <i>Tetrahedron</i> Vol. 43, No. 20. pp. 4609 to 4619, 1987, G.B.		
	CC	Calverley et al., "1 α , 24S-DIHYDROXY-26,27-CYCLO-22-YNE-VITAMIN D ₃ : THE SIDE CHAIN TRIPLE BOND ANALOGUE OF MC 903 (CALCIPOTRIOL), <i>Bioorganic & Medicinal Chemistry Letters</i> , Vol. 3, No. 9, pp. 1841-1844, 1993		
	CD	Sabroe, Thomas Peter, Chirale allylalkoholer ved asymmetrisk induktion, (master's thesis); DANMARKS TEKNISKE UNIVERSITET, Institut for Ogranisk Kemi, 1997; and Declaration containing partial English Translation		

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ²Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
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